

REMARKS

Claims 1, 13, 17, 22, and 29 have been amended to clarify the subject matter regarded as the invention. Claims 1 – 31 are pending.

The Examiner believes that the disclosure of application serial no. 09/282,157 to which this application claims priority fails to provide adequate support or enablement as required by 35 U.S.C. 112, first paragraph.

Applicants respectfully disagree. For convenience and without limitation, support for claim 1 may be found in the prior-filed application in Figures 3 and 4 and at page 12, lines 1 – 7. For convenience and without limitation, support for claim 13 may be found in the prior-filed application in Figures 3 and 4, page 13, lines 5 – 14, and page 12, lines 1 – 7. For convenience and without limitation, support for claim 17 may be found in the prior-filed application in Figures 3 and 4 and page 12, lines 1 – 7. For convenience and without limitation, support for claim 22 may be found in the prior-filed application in Figures 3 and 4, page 13, lines 5 – 14, and page 12, lines 1 – 7. For convenience and without limitation, support for claim 29 may be found in the prior-filed application in Figures 3, 4, 6B, and 6C and at page 12, lines 1 – 7. Applicants therefore believe the prior-filed application has sufficient support under 35 U.S.C. 112, first paragraph for the claims of this application.

The Examiner has rejected claims 1 – 3 and 6 – 16 under 35 U.S.C. 101 for not producing a useful result.

The rejection is respectfully traversed. MPEP 2107.01 states, “Where an applicant has set forth a specific and substantial utility, courts have been reluctant to uphold a rejection under 35 U.S.C. 101 solely on the basis that the applicant’s opinion as to the nature of the specific and substantial utility was inaccurate... Practical considerations require the Office to rely on the inventor’s understanding of his or her invention in determining whether and in what regard an invention is believed to be ‘useful.’ Because of this, Office personnel should focus on and be receptive to assertions made by the applicant that an invention is ‘useful’ for a particular reason.” Independent claims 1 and 13 respectively recite a method for “making bids received from each said bidder for said price and said non-price parameters available to said auction requester in

real-time” and a computer readable storage medium to “make said total bid along with each bid for a non-price parameter by each corresponding bidder available to said auction requester.” The claimed subject matter is associated with auctioning or bidding and (for convenience and without limitation) one application described by applicants is business to business electronic procurement (see, e.g., page 1, lines 23 – 29). As recited in claims 1 and 13, bids for non-price parameters are made available to the auction requester (e.g., a buyer). Some examples of non-price parameters include lead time, labor rate, and contract length and applicants disclose how it is desirable, at least in some cases, for such information to be bid upon in an auction (see, e.g., page 3, lines 22 – 27). Applicants further disclose that in some cases providing an auction requester with bidding information is desirable because the auction requester is kept abreast of a dynamically changing auction environment (see, e.g., page 4, lines 2 – 4). It is therefore believed that claims 1 and 13 provide a useful result. Claims 2 – 3 and 6 – 12 depend from claim 1 and claims 14 – 16 depend from claim 13 and are believed to provide a useful result for the same reasons described above.

The Examiner has rejected independent claims 1, 17, and 22 under 35 U.S.C. 102(b) as being anticipated by Ausubel.

The rejection is respectfully traversed. Amended claims 1, 17, and 22 recite, “said at least one non-price parameter includes a term of agreement regarding supply of a good and/or service, other than quantity of the good and/or service, between the auction requester and a given bidder that the auction requester and the given bidder agree to abide by in the event the given bidder is a winning bidder.” For convenience and without limitation, support for the amendment can be found at page 4, lines 16 – 17 and page 18, lines 15 – 25. In Col 4, lines 21 – 29 cited by the Examiner, Ausubel discloses bidders in an auction specifying the particular objects or number of objects desired by that particular bidder. This is not the same as a non-price parameter which “includes a term of agreement regarding supply of a good and/or service, other than quantity of the good and/or service, between the auction requester and a given bidder that the auction requester and the given bidder agree to abide by in the event the given bidder is a winning bidder” as recited in claims 1, 17, and 22. For example, the cheapest bid may not be acceptable if the lead time to supply the good and/or service is unacceptably long. Claims 1, 17, and 22 are therefore believed to be allowable.

Claims 2 – 12, 18 – 21, and 23 – 28 depend from claims 1, 17, and 22 (respectively) and are believed to be allowable for the same reasons described above.

The Examiner has rejected independent claim 13 under 35 U.S.C. 103(a) as being unpatentable over Ausubel in view of Parunak et al.

The rejection is respectfully traversed. Claim 13 has been amended to recite, “said at least one non-price parameter includes a term of agreement regarding supply of a good and/or service, other than quantity of the good and/or service, between the auction requester and a given bidder that the auction requester and the given bidder agree to abide by in the event the given bidder is a winning bidder.” For the same reasons cited above, it is believed that Ausubel does not disclose a non-price parameter as recited in claim 13. In paragraphs [0125] – [0127] of Parunak et al. cited by the Examiner, a buyer and a seller’s relative rankings or preferences for certain materials with respect to other materials are shown. “It prefers Wood 388 to either of Aluminum 390 or Steel 391, and both Aluminum 390 and Steel 391 to Ceramic 389, but is indifferent to Aluminum 390 with respect to Steel 391.” (paragraph [0124]) It is therefore believed that neither Ausubel nor Parunak et al. disclose a non-price parameter as recited in claim 13 and claim 13 is allowable.

Claims 14 – 16 depend from claim 13 and are believed to be allowable for the same reasons described above.

The Examiner has rejected independent claim 29 under 35 U.S.C. 103(a) as being unpatentable over Ausubel in view of Popolo.

The rejection is respectfully traversed. Claim 29 has been amended to recite, “said at least one non-price parameter includes a term of agreement regarding supply of a good and/or service, other than quantity of the good and/or service, between the auction requester and a given bidder that the auction requester and the given bidder agree to abide by in the event the given bidder is a winning bidder.” For the same reasons cited above, it is believed that Ausubel does not disclose a non-price parameter as recited in claim 29. In Col 14, line 50 – Col 16, line 24 of Popolo cited by the Examiner, a potential buyer is able to view the characteristics or specifications of an item being sold (e.g., gauge, width, and weight are shown in Panel #3) and/or search for certain commodities, dimensions, or sellers before making a bid. This is not a non-price parameter that “includes a term of agreement regarding supply of a good and/or service, other than quantity of the good and/or service, between the auction requester and a given bidder that the auction requester and the given bidder agree to abide by in the event the given

bidder is a winning bidder" as recited in amended claim 29. It is therefore believed that neither Ausubel nor Popolo disclose a non-price parameter as recited in claim 29 and claim 29 is allowable.

Claims 30 – 31 depend from claim 29 and are believed to be allowable for the same reasons described above.

The foregoing amendments are not to be taken as an admission of unpatentability of any of the claims prior to the amendments.

Reconsideration of the application and allowance of all claims are respectfully requested based on the preceding remarks. If at any time the Examiner believes that an interview would be helpful, please contact the undersigned.

Respectfully submitted,

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